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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

AVELLINO, JOSEPH E

ART UNIT	PAPER NUMBER
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2143

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/558,925

Applicant(s)

KEMBEL ET AL.

Examiner

Joseph E. Avellino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 31-77 are pending in this application; claims 31, 42, 50, and 62 independent.

2. In view of the Appeal Brief filed on March 5, 2007, PROSECUTION IS HEREBY REOPENED. A new rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-49 of Patent Application no. 09/558,924 contains every element of claims 31-77 of the instant application and as such anticipates claims 31-77 of the instant application.

4. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus)." ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Court, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 101

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 70-75 are rejected under 35 USC 101 because they are not statutory. The claim limitations (i.e. a reference to content data, and a frame definition) relate to non-functional descriptive material data on a storage medium and fail to establish a statutory category of invention for the claim. The invention merely recites a data object stored in memory, and therefore is not statutory." See *State Street*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Correction is required.

This is merely data per se, and is not considered statutory under 35 USC 101, because this data does nothing. See MPEP 2106 regarding patent subject matter eligibility.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 31-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Referring to exemplary claim 31, the claim recites the limitation, "wherein the visual manifestation and the internet content is not confined by a window of a web browser program" which attempts to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. In *re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). The limitation does not particularly point out what is actually claimed, rather than what the claim excludes, which renders the claim indefinite, since the scope of the limitation does not provide what is actually encompassed in the claim. Correction is required.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 31-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe (USPN 6,006,252) in view of Ko et al. (USPN 6,292,185) (hereinafter Ko).

11. Referring to claim 31, Wolfe discloses a method for presenting Internet content to a user of a computing device, comprising:

retrieving a first internet content (i.e. supplemental content) that is programmed in a format readable by a web browser program (Figures 13, 14, 16, and 19; col. 8, lines 30-48); and

rendering the first internet content to provide a visual manifestation of the first internet content on an output means of the computing device, wherein the visual manifestation of the first internet content is not confined by a window of a Web browser program (i.e. program 1535 displays the information, and therefore does not utilize the browser to render the supplemental information, and therefore the supplemental information cannot be confined by the web browser program), the internet content is rendered independently from a web browser program (i.e. program 1535 renders the supplemental content independently from the web browser 1530) (col. 8, lines 30-48).

Wolfe does not specifically disclose that the supplemental information contains a definition of a frame for the visual manifestation. In analogous art, Ko discloses another method for presenting internet content which includes defining how a GUI will be tailored in the web page (e.g. abstract; Figure 2; col. 5, lines 7-30). It would have been obvious to one of ordinary skill in the art to combine the teaching of Ko with Wolfe in order to allow the supplemental content to tailor program 1535 window with respect to the advertisement, thereby allowing a user to further distinguish their advertisement from another, and allowing a supplemental content provider to customize the appearance of a graphical web page free from the constraints of the browser as supported by Ko (col. 1, lines 45-50).

12. Referring to claim 32, it is inherent that the definition of the frame is programmed in a format readable by a web browser program since if it is displayed by the web

browser program it inherently must be programmed in a way such that the program is able to read the definition of the frame.

13. Referring to claims 33 and 34, Wolfe discloses the invention substantively as described in claims 31 and 32. Since claims 33 and 34 defines a second visual manifestation exactly the same as claims 31 and 32, and Wolfe discloses that multiple supplemental information windows can be rendered simultaneously (Figure 39; col. 18, lines 26-40), Wolfe clearly discloses the use of a second visual manifestation.

14. Referring to claim 37, Wolfe-Ko discloses the Internet content comprises JavaScript (Ko: col. 7, lines 60-67).

15. Referring to claim 42, Wolfe discloses the invention substantively as described in the claims listed above. Wolfe furthermore discloses a second visual manifestation of a frame through which the first visual manifestation is presented (the supplemental information can rotate on a timewise basis (Figure 26a and related portions of the disclosure).

16. Referring to claim 43, Wolfe discloses the receiving step comprises receiving the internet content from the web (Figure 2, ref. 253).

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17. Referring to claim 44, Furst discloses the receiving step comprises retrieving the internet content from a memory of the computing device (it is understood that the web page must be stored in memory before it can be rendered) (Figure 2).

18. Claim 46 is rejected for similar reasons as stated above.

19. Claims 50-77 are rejected for similar reasons as stated above since all limitations taught by the newly added claims are either expressly taught or implied by Wolfe and Ko. Furthermore it has been held obvious to make combined components separable. See *Nerwin v. Erlichman* 168 USPQ 177 (1969).

20. Referring to claims 35 36, and 45, Wolfe-Ko discloses the invention substantively as described in claim 31. Wolfe-Ko does not specify that the internet content comprises XML codes and XML tags for the frame definition. However it is well known that XML code is commonly downloaded over the Internet (i.e. web pages) and that in defining the frames of these web pages, XML tags are used in order to correctly define the frame. By this rationale it would have been obvious to one of ordinary skill in the art to include XML tags to the system of Wolfe-Ko to provide a more robust method of coding the icons and window bars associated with the invention, thereby allowing another method to provide third parties to code applications easily.

21. Referring to claims 38, Wolfe-Ko discloses the invention substantively as described above. Wolfe-Ko does not specifically disclose that JavaScript tags are used to define the frame of the window and bar, yet Ko does disclose that JavaScript can be used instead of VBScripting (see rejections above). However it is well known that JavaScript has the capability of defining a frame for the tool and one of ordinary skill in the art would find it obvious to do so. By this rationale it would have been obvious to one of ordinary skill in the art to include JavaScript tags in the code in order to provide a more robust method of coding the icons and windows and a bar in order to provide a language in which many browsers understand, thereby increasing the accessibility of the invention.

22. Referring to claims 39-41 and 47-49, Wolfe-Ko discloses the invention substantively as described in claim 31. Wolfe-Ko does not disclose that the Internet content includes creating a media player, a calculator or accessing streaming media. However these functions are well known to exist and one of ordinary skill in the art (i.e. calculation applets are prevalent on the web, media players can be inserted into web browsers, which would stream media from servers) would find it obvious to be able to encode a visual manifestation of these applications in order to provide the viewing public a copy of the application, thereby increasing the knowledge of the general public.

Response to Arguments

23. Applicant's arguments filed March 5, 2007 have been fully considered but they are moot in view of the new grounds of rejection presented above.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Joseph E. Avellino, Examiner
March 13, 2007



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